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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,123	03/27/2001	Katsuki Hazama	1737/00014	1669

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EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

10

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,123

Applicant(s)

HAZAMA, KATSUKI

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-17 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5,16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1 and 6-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/060,106.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1, and 6-15 drawn towards a plurality of multi-valued cells in Paper No. 5 is acknowledged.
2. Claims 2,3, 5,16, and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5. This requirement was made **FINAL** with paper No. 6.

Oath/Declaration

The copy of the oath or declaration has been received and entered with paper number 8.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 6, 7, 10, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693) in further view of Hikawa et al (US 5,526,306).

Gilboa teaches a computerized game including a game board (Elm 8) including a first control device for transmitting and receiving data required in terms of advancement in a game, a plurality of game pieces (Elm 10) each including data carrier having control means for transmitting and driving electric power (Col 11:22-32) and the transferring data between the game pieces and the body (Col 12:4-11) where the coil resonance system described provides the power to activate the game piece's transmission means through a query and the data transferred consists of the unique identification broadcast in reply to the body by the piece serves as the transferring of data as so claimed. Gilboa however is silent regarding the inclusion of a control unit with associated memory in his game pieces for the execution of processes/programs or the storage of the identifier in this memory.

In an analogous patent Zalewski teaches the inclusion of a control unit and associated memory (Col 11:10-54) with game pieces (bodies) for the execution of programs/processes (Col 12:3-27) along with the use of an identification or control signal (Col 11:55-61) but is silent regarding the use of a coil resonance system or the locating of the game pieces on a game body. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the control unit with

associated memory of Zalewski with the board game of Gilboa in order to allow the game pieces to independently determine their position through triangulation (and thereby add a 3rd dimension for position determination), run programs or processes external to the device or alternatively to allow the individual identification of each piece to be readily changed.

Alternatively it would have been obvious to one of ordinary skill in the art at the at the time of invention to have incorporated the coil resonance system of Gilboa as taught above with the control unit and associated memory Zalewski in order to provide a power means which would not require replacement.

The invention of Gilboa and Zalewski however is silent on whether binary or multi-state memory (wherein multi-state is understood to encompass at least 3 states) is used with their game pieces. However Hikawa et al teaches the use of multi-state memory in a method for memory device fabrication (Col 13:47 –54 & Abstract). It would have been obvious to utilize the multi-state memory of Hikawa et al in the game of Gilboa/Zalewski in order to conserve space and/or increase the amount of storage memory available to each piece (See Hikawa Abstract).

Regarding claim 15 and in addition to the above stated, the detection and response to the determination of the positional relationship as claimed is shown in figure 4-6 of Zalewski

6. Claims 8, 9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693) in further view of Hikawa et al (US 5,526,306) and yet further in view of Bergeron (US 4,764,666).

The invention of Gilboa/Zalewski/Hikawa or Zalewski/Gilboa/Hikawa is silent regarding the use of contact terminals and the storing of information identifying information.

Bergeron teaches in an on-line wagering system with programmable game entry cards that teaches the use of a contact terminal for transmitting and receiving via touch (Col 13:39-49) or electromagnetic waves (13:45-49) and the inclusion of player identifying information on the device including bank account numbers (3:25-38) as well as other player specific information for identifying the individual (7:45-55).

It would have been obvious to one of ordinary skill at the time of invention to have incorporated the invention of Bergeron with the invention of Gilboa/Zalewski/Hikawa or Zalewski/Gilboa/Hikawa as disclosed above in order to provide a system with increased security from fraudulent use, reduce electromagnetic interference generated through the contact terminals, or provide a method to locate the owner of lost game pieces.

Regarding at least claim 14 as best understood, the invention of Gilboa/Zalewski/Hikawa or Zalewski/Gilboa/Hikawa includes the ability to store information in a multi-value memory regarding the object moving said object. Wherein the "object" as presented is interpreted as a person.

Response to Arguments

7. Applicant's arguments with respect to claims 1, and 6-15 have been considered but are moot in view of the new ground(s) of rejection.

8. In reference to the applicants arguments centered on the Hikawa et al Patent previous relied upon in previous office action (paper 6) it is believed that the applicant is in error. In the arguments entered on 2-26-04 the applicant strongly suggests that the memory device is of a binary device type rather than the examiner's previously extended interpretation of the device as a multi-valued one.

Upon reviewing the reference again the examiner believes the conclusion reached by the applicant is in error for the following reasons:

- a. Hikawa describes his memory as being "multivalued" as presented on line 8 of the abstract establishing that Hikawa at least considered the term "multivalued" appropriate to his invention.
- b. Hikawa further defines "multivalued" in column 13 from line 47 through line 54 by describing the memory cell as being "multivalued to at least three values".

Additional arguments directed to the newly added limitations have been addressed in the presented rejections above and will not be addressed here.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. Cardinal (US 4,343,609) discloses a chess instruction apparatus.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

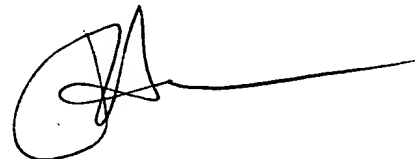
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line extending to the right.

JESSICA HARRISON
PRIMARY EXAMINER